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SIMONE, CATHERINE A				
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte RICHARD W. NYCAMP and DAVID A. STEIL

Appeal 2008-0510
Application 10/628,963
Technology Center 1700

Decided: March 28, 2008

Before EDWARD C. KIMLIN, THOMAS A. WALTZ and
JEFFERY T. SMITH, *Administrative Patent Judges*.

WALTZ, *Administrative Patent Judge*.

SMITH, *Administrative Patent Judge*, concurring-in-part.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the Examiner's non-final rejections of claims 17-19. We have jurisdiction as the claims have been twice presented and rejected. *See Ex Parte Lemoine*, 46 USPQ2d 1420,

1423 (BPAI 1998); 35 U.S.C. §§ 6(b) and 134(a). Appellants only present three of the six rejections by the Examiner in the nonfinal Office Action, dated October 5, 2006, for review in this appeal (App. Br. 5). The Examiner acknowledges that these rejections are not on review in this appeal but are not withdrawn (Ans. 3). Therefore, we find that Appellants have withdrawn their appeal of these 3 rejections, and our decision is therefore limited to those rejections presented for review in this appeal.

The invention of the application under review is directed to a decorative cover that is secured magnetically to metal office furniture. The cover comprises a laminate of a magnetic sheet and a decorative material. The cover is dimensioned to substantially cover a component of a furniture piece, such as a file drawer front. (Spec. 2). Independent claim 17 is illustrative and reproduced below:

17. An article of office furniture comprising:
a metal office furniture piece including a plurality of components each having dimensions; and
a plurality of magnetic decorative covers, each of said covers overlying and attached to one of said components, each of said covers having dimensions substantially the same as the dimensions of the component to which the cover is attached, each of said covers comprising a magnetic sheet and a decorative material selected from the group of fabric, vinyl, leather, veneer and laminate.

The Examiner relies on the following prior art¹:

¹ The three cited references formed the basis of the rejections in the non-final Office Action. The Examiner cited six additional references in her Answer for providing further support on the same issues at bar. However,

Barler	2,438,108	Mar. 23, 1948
Martinez	3,697,363	Oct. 10, 1972
Vela	2001/0008702 A1	Jul. 19, 2001

Claim 17 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Martinez. Claims 17 and 19 stand rejected under 35 U.S.C. § 103(a) as obvious over Martinez in view of Barler. Claims 17 – 19 stand rejected under 35 U.S.C. § 103(a) as obvious over Vela.

Regarding the rejection of claim 17 as anticipated by Martinez, Appellants contend that Martinez does not teach metal office furniture, according to a construction of that term offered by Appellants. They also contend that the panel inserts disclosed in Martinez are not substantially the same dimensions as the magnetic sheet elements to which the inserts are attached, and that the insert is attached to many, smaller elements.

Regarding the rejection of claims 17 and 19 as obvious over Martinez in view of Barler, Appellants repeat their argument that Martinez does not disclose the use of decorative panels with metal office furniture, and that Martinez provides no suggestion for using decorative panels with metal office furniture. They further argue that Barler disclosed metal office furniture, but fails to teach or suggest decorative magnetic covers.

since these additional references have not been listed in the statement of any rejection, we do not consider them as part of the evidence of unpatentability. See *In re Hoch*, 428 F.2d 1341, 1342 n.3 (CCPA 1970). However, we have considered the Decision in Appeal No. 2005-1709, S.N. 09/999,400, dated Aug. 30, 2005.

As to the rejection of claims 17–19 as obvious in view of Vela, Appellants contend that Vela fails to teach the limitation of a decorative magnetic cover that is substantially dimensioned to the furniture element to which the cover will attach.

Finally, Appellants contend that any evidence of obviousness is rebutted by their evidence presented of secondary considerations, namely several awards by furniture industry trade associations and publications.

ISSUES ON APPEAL

1. Did Appellants show that the Examiner reversibly erred in her construction of the claim term, “metal office furniture”?
2. Did Appellants show that the Examiner reversibly erred in her finding that Martinez discloses a metal decorative cover dimensioned substantially to a furniture element to be covered?
3. Did Appellants show that the Examiner reversibly erred in finding that claim 17 is anticipated by Martinez?
4. Did Appellants show that the Examiner reversibly erred in finding that claims 17 and 19 are obvious over Martinez in view of Barler?
5. Did Appellants show that the Examiner reversibly erred in finding that claims 17 – 19 are obvious over Vela?
6. Did the Appellants show that the Examiner reversibly erred in finding that any prima facie case of obviousness was not rebutted by evidence of secondary considerations?

FINDINGS OF FACT (FF)

1. Martinez discloses decorative panels which are dimensioned to fit substantially within the borders of furniture elements. (Martinez, col. 3, ll. 55–60).

2. Martinez does not explicitly disclose or limit the material of construction of the furniture piece to which its invention is applied, though the drawings use a symbol typically used by those skilled in the art as indicative of wood (e.g., see Figs. 4, 6 and 7).

3. One embodiment of Martinez teaches permanently adhering a sheet of conductive metal to the face of a furniture element to be covered by the decorative panel, the decorative panel comprising magnets and decorative material. (Martinez, Fig. 8; col. 5, ll. 5–11).

4. Martinez teaches a decorative panel comprising a plurality of magnetic sheet elements laminated between two decorative sheets. The disclosure does not limit the number of magnetic sheet elements or the extent of any gap or spacing between the elements. (Martinez, col. 3, l. 70 – col. 4, l. 12).

5. Vela discloses a decorative cover comprising a magnetic layer laminated with a decorative material which can adhere to metal furniture, including filing cabinets. (Vela, 1, ¶ [0013]).

6. Barler discloses filing cabinets, a species of office furniture, made entirely of metal. (Barler col. 1, ll. 1 – 2).

7. The evidence of secondary factors presented by Appellants comprises awards from industry trade associations and publications. The

two awards considered by Appellants as most prestigious were in the categories of “workplace productivity” and “workplace aesthetics”. The evidence does not include any of the standards by which those awards are judged. The awards merely represent the lay opinions of third parties based on undisclosed and non-legal standards. (App. Br., app. IX).

8. The evidence does not include any showing of immediate commercial success, of unexpected results, of solving a long-standing problem confronting the industry, nor of any fulfillment of a long-felt need.

9. The evidence of secondary considerations includes evidence not only of magnetic furniture panels having a decorative material layer, but also of panels having a functional layer, namely a dry erasable marker surface, trademarked “Jot It”. (App. Br., app. IX). The awards do not differentiate between panels having decorative or functional materials.

PRINCIPLES OF LAW

Claims are given the broadest reasonable construction consistent with the specification. *In re Morris*, 127 F.3d 1048, 1054 (Fed. Cir. 1997). “The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction ‘in light of the specification as it would be interpreted by one of ordinary skill in the art.’ *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). However, the broadest reasonable interpretation of the claims

must also be consistent with the interpretation that those skilled in the art would reach. *In re Cortright*, 165 F.3d 1353, 1358, (Fed. Cir. 1999).

To properly compare a prior art reference with the claims at issue, the claim must first be properly construed. *Gechter v. Davidson*, 116 F.3d 1454, 1457 (Fed. Cir. 1997). The specification is always highly relevant to the claim construction analysis. Usually, it is dispositive; it is the single best guide to the meaning of a disputed term. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1315 (Fed. Cir. 2005). Although claims are to be interpreted in light of the specification, limitations from the specification are not to be read into the claims. *See In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993). The scope of a disputed term is not limited by the preferred embodiments absent an express disclaimer by Appellant of a broader definition. *See In re Bigio*, 381 F.3d 1320, 1325 (Fed. Cir. 2004).

Under 35 U.S.C. § 102, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987).

Under 35 U.S.C. § 103(a), the question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield

predictable results. *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734 (2007).

“When prima facie obviousness is established and evidence [of secondary considerations] is submitted in rebuttal, the decision maker must start over. ... Prima facie obviousness is a legal conclusion, not a fact. Facts established by rebuttal evidence must be evaluated along with the facts on which the earlier conclusion was reached, not against the conclusion itself. ... [A] final finding of obviousness may of course be reached, but such finding will rest upon evaluation of all facts in evidence, uninfluenced by any earlier conclusion reached by an earlier board upon a different record.” *In re Rinehart*, 531 F.2d 1048, 1052 (CCPA 1976). Objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support. *In re Tiffin*, 448 F.2d 791 (CCPA 1971). “Case law requires that a nexus be established between the merits of the claimed invention and the evidence proffered on secondary considerations, if the evidence on secondary considerations is to be given substantial weight in the calculus of obviousness/nonobviousness.” *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 776 F.2d 281, 305 n. 42 (Fed. Cir. 1985).

ANALYSIS

Claims Construction

Metal Office Furniture

Claim 17 is directed to “metal office furniture.” The Examiner contends that this term means “furniture with any part that is metal.” (Ans. 4). Appellants contend that this is too broad, “literally everyone knows what metal office furniture is” (App. Br., p. 6). Common knowledge does not provide a sufficiently definitive definition.

Appellants properly point to the Specification, which describes metal office furniture as that which is “fabricated of steel” (Spec. 1:7). This may limit the type of metal used in office furniture, as compared to, e.g., aluminum, but does not resolve the extent of metal components sufficient to classify office furniture as “metal.” But the Specification adds, “The application could be any article of metal office furniture, such as flipper doors, file cabinets, ... The surface on which the cover is installed could be virtually any metal component of the office furniture article” [Spec. 4:11-14; emphasis added]. From the Specification, one skilled in the art would understand that, for the invention to function, the surface of a furniture component must be of metal, to provide a base to which a decorative cover can magnetically adhere. We therefore construe the term, “metal office furniture” as “furniture having components with metal surfaces to which a magnetic surface can adhere.”

Anticipation by Martinez – Claim 17

Appellants appeal the rejection of claim 17 as anticipated by Martinez. The Examiner contends that Martinez teaches each and every element of claim 17, which is set forth in the Office Action of Oct. 5, 2006. Appellants first contend that Martinez does not teach of “metal office furniture.” We disagree. Martinez teaches furniture comprising components having steel surfaces, fabricated by permanently adhering a sheet of metal to the component surface to be covered. (FF 3). As we have construed the claim term, “metal office furniture,” we determine that this claim term reads on the disclosure in Martinez.

Appellants then argue the Martinez panel insert members are not “substantially the same as” the dimensions of the magnetic sheet elements to which the inserts are attached, and that the Martinez inserts are attached to many [magnetic] elements, each of which is far smaller than the insert. (App. Br. 6). However, claim 17 does not limit the dimensions or number of the magnetic sheet(s) comprising the cover; it only limits the size of the cover itself, which comprises a magnetic sheet and decorative material, to the dimensions of the furniture component to be overlaid by the cover. The transitional term “comprising” is “inclusive or open-ended and does not exclude additional, unrecited elements or method steps.” *Georgia-Pacific Corp. v. United States Gypsum Co.*, 195 F.3d 1322, 1327 (Fed. Cir. 1999). We find nothing in the specification nor claim limiting the cover to a single

magnetic sheet and single decorative fabric sheet both necessarily of the same overall dimensions as the fabricated cover.

In Martinez, the fabricated panel insert 12', analogous to the cover of the present invention, has dimensions substantially the same as the furniture component 36' being covered. (Martinez, Fig. 5; col. 3, ll. 55 – 63). While Appellants' disclosure in their Specification is directed only to an embodiment comprising a single magnetic sheet and a single piece of decorative material, the broadest reasonable interpretation of claim 17 would not be so limited. In Martinez, the magnetic sheet elements 38' are disposed in a coplanar grid or array between two decorative sheets 12f', 12g'. (See Martinez, Fig. 7). The number, size or spacing between the magnetic sheet elements is not limited. In the extreme, the number and size of the magnetic sheet elements could be to the extent that the magnetic elements forming the array have no gap between them, effectively creating a continuous single magnetic sheet analogous to Appellants' magnetic sheet in their cover. We therefore determine that the point argued by Appellants is irrelevant to determining the anticipation of claim 17 by Martinez

Obviousness over Martinez in view of Barler – Claims 17 and 19

The Examiner rejected claims 17 and 19 as obvious over Martinez in view of Barler. The Examiner contends, in the alternative to the prior anticipation rejection, that Martinez discloses all the limitations of claim 17 except possibly the metal office furniture, while Barler discloses an office file cabinet, and substituting the metal file cabinet of Barler with the other

elements of Martinez would have been obvious to one skilled in the art. (Ans. 2–4). Barler is offered merely to show that metal office furniture was known in the art at the time invention was made. But, as we have found that claim 17 is anticipated by Martinez, *supra*, anticipation is also the epitome of obviousness. See *In re Fracalossi*, 681 F.2d 792, 794 (CCPA 1982). Further references showing knowledge in the art of this contested element only reinforce the rejection. Appellants’ argument against this rejection is that Barler fails to disclose, teach or suggest the use of magnetic covers. However, the test for obviousness is not limited to the “teaching-suggestion-motivation” test. *KSR Int’l Co.*, 127 S.Ct. at 1441. A combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results. *Id.* at 1739.

We therefore sustain the rejection of claim 17 as obvious over Martinez in view of Barler.

Claim 19 depends on claim 17, inheriting all limitations contained therein, and adding a further limitation of a decorative cut-out in the cover. As the Examiner correctly points out, such a cut-out is merely decorative or ornamental. It is analogous to a printed design, but here using negative space to display the image of a logo or graphical design. The cut-outs are created by laser cutting or die-cutting (Spec. 5:21 – 6:17), both well-known in the art. Therefore, adding a decorative cut-out is merely an obvious design choice. “As our precedents make clear, however, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative

steps that a person of ordinary skill in the art would employ.” *KSR Int’l.*, 127 S.Ct. at 1441.

We therefore determine that the examiner has established a prima facie case of obviousness.

Obviousness over Vela – Claims 17 – 19.

Claims 17 – 19 stand rejected as obvious over Vela. Vela discloses a decorative cover comprising a magnetic sheet and a decorative material which is applied to metal furniture, including file cabinets (FF 5). Appellants contend that Vela does not disclose a cover that is dimensioned substantially the same as the component to be covered. (App. Br. 9). It is apparent from the Specification that the purpose of the decorative cover is to provide an aesthetically pleasing appearance on the furniture component. As such, a person of ordinary skill in the art would have had sufficient skill to determine the appropriate dimension for the decorative cover dependent upon how much coverage of the furniture is desired. *KSR Int’l.*, 127 S. Ct. at 1742. It is only a dimensional limitation which does not cause the invention to perform or operate any differently from the prior art. *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 1349 (Fed. Cir. 1984). Appellants have not shown that the difference in physical dimensions is critical to achieve some unexpected result relative to the prior art. *In re Woodruff*, 919 F.2d 1575, 1578 (Fed. Cir. 1990).

We determine, therefore, that the examiner has established a prima facie case of obviousness.

Secondary Considerations

Once a prima facie case of obviousness is made, an Applicant may rebut the finding with evidence of secondary considerations. The Appellants have submitted evidence in the form of a number of awards issued by several trade associations and publications. They have also submitted news releases about the product published in trade publications.

The Examiner contends that the submitted evidence was not persuasive because the evidence was not commensurate with the scope of the claims. (Ans. 18). We agree with the Examiner's conclusion. As noted from the submitted press releases, the product, as marketed, includes functional as well as decorative materials on the cover (FF 9). It is unclear to what extent the product models with functional surfaces contributed to the presented awards. To the extent that the awards evidence a valid secondary consideration, if any, it may go to the functional version. Thus, the evidence is not commensurate with the scope of the claims, and we give it little weight. *Tiffin*, 448 F.2d at 792.

The proffered evidence is also not persuasive because it does not show immediate commercial success, solving a long-standing problem confronting the industry, nor fulfillment of any long-felt need (FF 8). See *Graham*, 383 U.S. at 35. Likewise, it does not show unexpected results or any teaching away from the combination. The standards and criteria by which the awards are decided have not been provided, and merely reflect a subjective opinion of a lay third-party (FF 7). Appellants cite no case law

showing the relevance of this type of evidence as secondary considerations. After considering the evidence, we can give little probative weight to it. We determine that the Appellant has failed to provide sufficient evidence to rebut the prima facie case of obviousness made in the two § 103(a) rejections.²

CONCLUSION

In summary, we sustain the rejection of claim 17 under §102(b) as anticipated by Martinez, of claims 17 and 19 under § 103(a) as obvious over Martinez in view of Barler, and of claims 17–19 under § 103(a) as obvious over Vela.

SMITH, Administrative Patent Judge, concurring-in-part.

I concur with the panel's decision to affirm the Examiner's rejections of claim 17.

According to the notice of appeal³ in this case, “Applicant hereby appeals to the Board of Appeals from the last decision of the examiner.” The decision preceding the notice of appeal was a Non-Final rejection mailed October 5, 2005. This office action included six different rejections for various combinations of claims 17-19. These rejections are as follow:

² Secondary considerations are irrelevant in a § 102 rejection for anticipation.

³ Filed November 22, 2006.

I. Claim 17 is rejected under 35 U.S.C. § 102(b) as being anticipated by Martinez.

II. Claims 17 and 19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Martinez in view of Barler.

III. Claims 17-19 are rejected under 35 U.S.C. § 103(a) as unpatentable over Vela.

IV. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez in view of Barler and further in view of Vela.

V. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez in view of Vela.

VI. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Martinez.

Appellants in their Brief, filed January 22, 2007, indicated that the grounds of rejection to be reviewed on appeal included only the rejections designated as I-III above. (App. Br. 5). The Examiner in the Answer, filed May 16, 2007, indicated that the rejections designated as IV-VI “have not been withdrawn by the examiner, but they are not under review on appeal because they have not been presented for review and the Appellants brief.” (Answer 2). It is noted that no reply brief has been filed in response to the examiner's statement. My colleagues in the present application have acknowledged the presence of the six rejections included in the office action from which Appellants have based this appeal. However, they have indicated that three of these rejections (IV-VI) have not been presented for

review. (*Slip op.* 1-2). In my opinion the present record is unclear because of the treatment of the claims subject to the rejections IV-VI.

Rule 41.37(b) provides that an appeal shall be dismissed if no brief is filed. In this case, no brief was filed as to the rejections IV-VI. The rule clearly contemplates that the Board shall not be required to review a rejection in the absence of a brief dealing with it. If Appellants do not point out any alleged errors in the examiner's action the Board cannot properly be required to assume the burden of searching for such errors. Consequently, the appeal as to rejections IV-VI should be dismissed. *See In re Dismissal of Appeal to Board of Appeals if No Brief Is Filed*, 1966 C.D. 46, 833 O.G. 901, 152 USPQ 292, (Commissioner of Patents 1966) (Addressing the failure to brief a rejection to the board under 37 CFR § 192, the predecessor to 37 CFR § 41.37). Thus, the only claim remaining on appeal is therefore, claim 17.

TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED

Appeal 2008-0510
Application 10/628,963

tc

WARNER NORCROSS & JUDD LLP
900 FIFTH THIRD CENTER
111 LYON STREET, NW
GRAND RAPIDS, MI 49503-2487